

Serial No.: 09/929,769
Filed: August 14, 2001
Reply to Office Action of July 23, 2004

REMARKS

Claims 1-15 were pending for prosecution in this application. Applicants have herein canceled Claim 1 without prejudice or disclaimer and have amended Claim 2, thereby leaving Claims 2-15 pending for prosecution herein.

The Objection to the Amendment Filed April 30, 2004

As requested by the Examiner, Applicants have amended the priority statement found in the first full paragraph of the specification such that it no longer makes reference to an incorporation by reference of the claimed priority documents. It is believed that this amendment obviates the outstanding new matter objection.

The Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In support of the rejection, the Examiner asserts that the claims are drawn to a genus of antibodies that bind to "a genus of polypeptides having 80% sequence identity to the amino acid sequence shown as SEQ ID NO:7" and since the present specification allegedly fails to provide written description support for this genus of polypeptides, it necessarily follows that the specification also fails to provide sufficient written description support for the claimed antibodies.

Without necessarily agreeing with the propriety of the rejection, Applicants have canceled Claim 1. As Claim 1 is the only claim that makes reference to the genus of polypeptides having at least 80% sequence identity to the polypeptide sequence shown as SEQ ID NO:7, it is believed that cancellation of this claim obviates the outstanding rejection.

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The Rejection under 35 U.S.C. § 102(e)

Claims 1-9 and 12-15 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. US 2002/0164646 A1. Applicants respectfully traverse the rejection.

Initially, Applicants note the Examiner's comments in the present Office Action which indicate that the present application is entitled to an effective filing date of February 10, 1999 based upon U.S. Provisional Application Serial No. 60/119,537 which was filed on that date and to which the present application claims priority.

In reviewing the co-owned application giving rise to the US 2002/0164646 A1 publication cited by the Examiner in support of the present rejection, the undersigned notes that this published application claims priority to certain applications that were filed prior to the February 10, 1999 date to which the present application enjoys benefit of priority. Those "earlier filed" applications to which the cited US 2002/0164646 A1 published application claims priority are:

- (1) U.S. provisional application no. 60/095,325, filed August 4, 1998;
- (2) U.S. provisional application no. 60/112,851, filed December 16, 1998;
- (3) U.S. provisional application no. 60/113,145, filed December 16, 1998;
- (4) U.S. provisional application no. 60/113,511, filed December 22, 1998;
- (5) U.S. provisional application no. 60/115,558, filed January 12, 1999;
- (6) U.S. provisional application no. 60/115,565, filed January 12, 1999;
- (7) U.S. provisional application no. 60/115,733, filed January 12, 1999; and
- (8) U.S. provisional application no. 60/119,341, filed February 9, 1999.

As all of these "earlier filed" provisional applications are owned by the same assignee as the present application, the undersigned has been able to review the specifications of all of these "earlier filed" provisional applications. In this regard, it is noted that none of these "earlier filed" provisional applications disclose the polypeptide sequence shown in the present application as SEQ ID NO:7 nor antibodies that bind to this polypeptide sequence as presently claimed. Therefore, for purposes

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of establishing a prior art effect under 35 U.S.C. § 102, the cited US 2002/0164646 A1 publication is not effective prior art as of any of those “earlier” dates.

Applicants do note, however, that the US 2002/0164646 A1 publication cited by the Examiner does claim priority to U.S. provisional application no. 60/119,537, filed on February 10, 1999 (i.e., the same application to which the present application claims and enjoys priority benefit). As such, it appears that the US 2002/0164646 A1 publication cited by the Examiner in support of the rejection under 35 U.S.C. § 102(e) is effective prior art only as of February 10, 1999, i.e., the same date to which the present application enjoys priority benefit. As such, the US 2002/0164646 A1 publication cited by the Examiner is simply not effective prior art to the present application for purposes of supporting a rejection under 35 U.S.C. § 102(e). This rejection is improper and should, therefore, be withdrawn.

The Rejection under 35 U.S.C. § 103

Claims 1, 2, 7, 10 and 11 stand rejected under 35 U.S.C. § 103 as allegedly being obvious over U.S. Patent Application Publication No. US 2002/0164646 A1 in view of Liu et al. Applicants respectfully traverse the rejection.

As described above in response to the outstanding rejection under 35 U.S.C. § 102(e), the US 2002/0164646 A1 publication is effective prior art for purposes of 35 U.S.C. §§ 102 and 103 only as of the filing date of U.S. provisional application no. 60/119,537, namely February 10, 1999. As such, this reference is simply not prior art that can be employed against the present application in support of a rejection under 35 U.S.C. § 103. Moreover, the Liu et al. article does not teach or render obvious the polypeptide sequence disclosed in the present application as SEQ ID NO:7 or antibodies that bind to this polypeptide sequence as presently claimed. Therefore, Applicants respectfully submit that the present rejection is improper and should be withdrawn.

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The Double Patenting Rejections

Claims 1-3 and 5 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 18 and 19 of copending application serial no. 10/439,249. The Examiner asserts that the claims, while not identical to the currently pending claims, are not patentably distinct therefrom. Applicants respectfully traverse the rejection.

The undersigned has reviewed the pending claims in copending application serial no. 10/439,249 and has determined the following. Claims 18 and 19 of the 10/439,249 application cited by the Examiner are no longer pending for prosecution before the USPTO. Those claims were canceled in a preliminary amendment filed in the 10/439,249 application on July 7, 2003. The pending claims in the 10/439,249 application (i.e., Claims 22-39) are directed to certain nucleic acids, vectors and host cells and, therefore, are patentably distinct from the claims pending in the current application. This rejection should, therefore, be withdrawn.

Moreover, the Examiner asserts that current Claims 1-3 and 5 are directed to the "same invention" as that of Claims 18 and 19 of commonly assigned copending application serial no. 10/439,249. Again, for the reasons set forth above, Claims 18 and 19 are no longer pending in copending application serial no. 10/439,249 and this rejection should, therefore, be withdrawn.

Claims 1-3 and 5 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 18 and 19 of copending application serial no. 10/032,990. The Examiner asserts that the claims, while not identical to the currently pending claims, are not patentably distinct therefrom. Applicants respectfully traverse the rejection.

The undersigned has reviewed the pending claims in copending application serial no. 10/032,990 and has determined the following. Claims 18 and 19 of the 10/032,990 application cited by the Examiner are no longer pending for prosecution before the USPTO. Those claims were canceled in a preliminary amendment filed in the 10/032,990 application on December 27, 2001.

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The pending claims in the 10/032,990 application (i.e., Claims 22-41) are directed to certain nucleic acids, vectors and host cells and, therefore, are patentably distinct from the claims pending in the current application. This rejection should, therefore, be withdrawn.

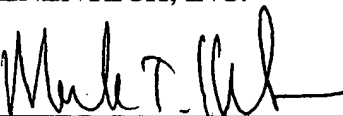
Moreover, the Examiner asserts that current Claims 1-3 and 5 are directed to the "same invention" as that of Claims 18 and 19 of commonly assigned copending application serial no. 10/032,990. Again, for the reasons set forth above, Claims 18 and 19 are no longer pending in copending application serial no. 10/032,990 and this rejection should, therefore, be withdrawn.

In light of the above amendments and remarks, Applicants believe that this application is now in condition for immediate allowance and respectfully request that the outstanding rejections be withdrawn and this case passed to issue.

The Examiner is invited to contact the undersigned at (650) 225-4461 if any issues may be resolved in that manner.

Respectfully submitted,

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